REMARKS

Claims 1-3, 5, 7-22, 24-25, 27 were previously presented. Claims 4, 6, 23, 26, and 28-138 were previously canceled. Accordingly, claims 1-3, 5, 7-22, 24-25, and 27 are pending examination.

Rejection of Claims 1 Under 35 USC §102(e) in view of Munshi

Claims 1 stands rejected under 35 USC §102(e) as being anticipated by U.S. Patent Publication No. 2003-0211383 A1 (Munshi).

Claim 1 specifies that "one or more cathodes (have) a total capacity less than a total capacity of the one or more anodes." Applicant has reviewed Munshi and cannot find any teaching of one or more cathodes having a total capacity less than the total capacity of the one or more anodes.

The Office Action indicates that it is relying on inherency for the claimed teaching. In order to comply with MPEP §2212(IV), a proper inherency rejection requires that Munshi's teachings necessarily result in one or more cathodes having a total capacity less than a total capacity of the one or more anodes.

The inherency rejection relies on the argument that "such properties are inherent, given that both Munshi et al. and the present application use the same chemistry in the battery." However, chemistry does not control the relative capacities of the anodes and cathodes. Consider that the capacity of an electrode can be changed merely by changing the amount of active material in that electrode and without changing the chemistry of the electrode. As an example, merely decreasing the amount of the active material on a cathode decreases the capacity of the cathode. As a result, the chemistry of an anode and cathode does not indicate the relative capacities of the anode and cathode. Since chemistry does not control relative capacities, the Office Action's assertion that "Munshi et al. and the present application use the same chemistry" does not support the conclusion that Munshi's teaching necessarily result in one or more cathodes having a total capacity less than one or more anodes." As a result, Munshi's teachings do not necessarily result in every element of claim 1 and accordingly do not support a proper inherency rejection.

Additionally, Applicant does not concede that Munshi is prior art for the current Application. Applicant reserves the right to present evidence that Munshi is not available as prior art for the current Application.

Rejection of Claim 1 Under 35 USC §102(b) in View of Skotheim

Claims 1, 5, 8, 12-22, and 27 are rejected under 35 USC §102(b) as being anticipated by U.S. Patent No. 5,462,566 (Skotheim). Skotheim teaches secondary batteries (See title, etc), however, applicant is claiming primary batteries. Since primary batteries are different from secondary batteries, Skotheim does not anticipate claim 1.

Additionally, Applicant has reviewed Skotheim and cannot find any teaching of one or more cathodes having a total capacity less than the total capacity of the one or more anodes. The applicant respectfully requests that the Examiner indicate where these teachings can be found in Skotheim. In the event that these teachings cannot be found in Skotheim, the arguments presented above with respect to Munshi also apply to Skotheim.

Claims 2-3, 5, 7-22, 24-25, and 27

Claims 2-3, 5, 7-22, 24-25, and 27 each depends from claim 1. Since claim 1 is believed to be in condition for allowance, these claims are also believed to be in condition for allowance.

CONCLUSION

The Examiner is encouraged to telephone or e-mail the undersigned with any questions.

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